



NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES		Docket Number (Optional) 3620-021	
Date <u>5/18/01</u>		In re Application of <u>Burns, Jr. et al.</u>	
Label No. <u>EL856658719 US</u>		Application Number <u>09/228,954</u>	Filed <u>January 12, 1999</u>
I hereby certify that, on the date indicated above, I deposited this paper with identified attachments and/or fee with the U.S. Postal Service and that it was addressed for delivery to the Assistant Commissioner for Patents, Washington, DC 20231 by "Express Mail Post Office to Addressee" service.		For <u>A Surface Covering Backing Containing Polymeric Microspheres And Processes Of Making The Same</u>	
Name (Print) <u>Sandra Stokinski</u> Signature <u>Sandra Stokinski</u>		Group Art Unit <u>1771</u>	Examiner <u>C. JUSKA</u>

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision of the examiner dated, January 18, 2001, rejecting the following claims: 23-68.

The fee for this Notice of Appeal is (37 CFR 1.17(b))

\$ 310.00

- ☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:
- ☒ A check covering the amount of the fee is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Commissioner has already been authorized to charge any fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, by credit any overpayment to Deposit Account No. 50-0925. I have enclosed a duplicate copy of this sheet.
- ☒ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ attorney or agent of record.
- ☐ attorney or agent acting under 37 CFR 1.34(a).
Registration number if acting under 37 CFR 1.34(a). _____

[Signature]
Signature

Luke A. Kilyk, Reg. No. 33,251

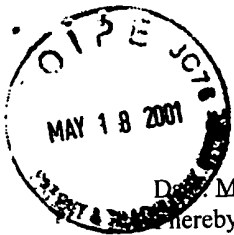
Typed or printed name

May 18, 2001
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

* Total of _____ forms are submitted.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



Date: May 18, 2001 Label No. EL856658719US

I hereby certify that, on the date indicated above, I deposited this paper with identified attachments and/or fee with the U.S. Postal Service and that it was addressed for delivery to the Assistant Commissioner for Patents, Washington, DC 20231 by "Express Mail Post Office to Addressee" service.

Sandra Stocklinski

Name (Print)

Sandra Stocklinski
Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

Alonzo M. BURNS et al.)

Application No.: 09/228,954)

Group Art Unit: 1771

Filed: January 12, 1999)

Examiner: C. JUSKA

For: A SURFACE COVERING BACKING CONTAINING POLYMERIC
MICROSPHERES AND PROCESSES OF MAKING THE SAME

REQUEST TO REMOVE FINALITY OF OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

Applicants respectfully request that the Examiner remove the finality of the Office Action dated January 18, 2001 in the above-identified application.

In the Office Action, the Examiner has relied upon new references to support § 102 rejections and further, the Examiner has altered her position with respect to the interpretation of certain claims. The reliance on new references and the Examiner's altered position on the interpretation of certain claims were not mandated by any amendment by applicants.

In more detail, at page 4 of the final Office Action, the Examiner rejected certain claims under 35 U.S.C. § 102(b). However, the Examiner has now decided that certain limitations in claims 58 and 59 are "method limitations within an article claim." However, this is contrary to the Examiner's position taken in the first Office Action dated August 2, 2000. In the first Office Action, the Examiner did not raise this rejection and in fact considered the various phrases as product limitations. It is only after applicants overcame the rejection in view of different references that the Examiner decided to alter her position with the interpretation of these claims. This altered position is in essence a new rejection which would mandate a non-final Office Action.

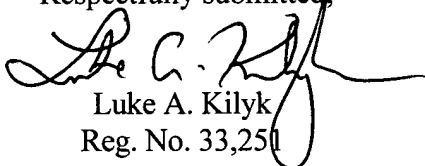
Request to Remove Finality of Office Action
U.S. Patent Application No. 09/228,954
Page 2

In addition, as reflected by PTO-892, the Examiner is now relying on two new references to support certain § 102 rejections. In particular, at page 6 of the final Office Action, the Examiner has rejected claim 25 based on previous arguments but now is relying on a certain portion of a book entitled "Carpet Substrates." This particular reliance on an additional reference was not mandated by any amendment by applicants and was specifically used by the Examiner to attempt to explain what the term "carpets" meant in the primary references. Clearly, this reliance on a new reference mandates that the finality of this Office Action be removed since according to MPEP § 706.07, an Office Action cannot be final where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement filed under 37 C.F.R. § 1.97(c). As indicated above, since neither of these exceptions apply, the Examiner has essentially introduced a new ground of rejection, and thus the finality of this Office Action is improper and should be withdrawn.

For these reasons, the Examiner is respectfully requested to remove the finality of the Office Action. Applicants reserve the right to Petition the Group Director or other appropriate official at the USPTO should the Examiner decline to withdraw the finality of the Office Action.

In the event that any fees are due in connection with this paper, please charge such fees to Deposit Account No. 50-0925. A duplicate copy of this paper is enclosed herewith.

Respectfully submitted,


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Reg. No. 33,251

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